

REMARKS

I. Status of Claims

Claims 1-10 have been canceled herein without prejudice. New claims 11-34 have been added. The specification and original claims provide written description support under 35 U.S.C. § 112, first paragraph, for the new claims. Support for new claims 11-34 can be found in the originally-filed specification, including the Examples and original claims. No new matter has been introduced.

II. Drawings

Applicants note that the Examiner, in the Office Action Summary, has indicated that the drawings filed October 1, 2003, have been objected to by the Examiner. Applicants did not file drawings on October 1, 2003, nor does the as-filed application contain any drawings. Therefore, Applicants respectfully request clarification on the record of the objection.

III. Obviousness-Type Double Patenting Rejection

Claims 1-3, 6-8, and 10 have been rejected for obviousness-type double patenting over claims 1-3, 6-8, and 10-13 of U.S. Patent No. 6,660,746 to Schindler et al. Because claims 1-10 have been canceled herein and new claims 11-34 have been added, this rejection has been rendered moot. Applicants therefore respectfully request that this rejection be withdrawn.

IV. Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1-10 have been rejected under 35 U.S.C. § 112 as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard

as the invention. The Examiner has made several rejections § 112, second paragraph, each of which is addressed below in turn.

A. Discussing claim 1, the Examiner alleges that “it is not very clear as to what applicants want to present,” as regards the claim language “C3-C7 cycloalkyl or are C3-C9 cycloalkyl which can be substituted” Office Action at 3. Although claim 1 has been canceled herein, Applicants assert that new claim 11, containing similar claim language, is not indefinite. Applicants have presented new claim 11, however, to more clearly demonstrate that the (C₃-C₇)cycloalkyl is not being claimed for R1 and R2 separately, but rather the (C₁-C₈)alkyl may be substituted with (C₃-C₇)cycloalkyl. Moreover, in response to the Examiner’s question regarding whether “the compounds of C8-C9 unsubstituted in nature [are] excluded to avoid any prior art . . . ,” (Office Action at 3), Applicants points out that unsubstituted (C₃-C₉)cycloalkyls are expressly claimed herein and are not excluded. Therefore, Applicants respectfully request withdrawal of this rejection.

B. According to the Examiner, claim 2 “reads onto a wider scope rather than limiting the scope.” Office Action at 3. Applicants disagree and note that the Examiner has failed to demonstrate, as he must, how a “(C₃-C₉)-cycloalkyl optionally substituted” is broader than a “(C₃-C₉)-cycloalkyl which can be substituted” And as Applicants explained above, the (C₃-C₇)-cycloalkyl does not refer to R1 and R2, but rather to optional substituents on the (C₁-C₈)-alkyl. The rejection, however, is mooted by the present cancellation of claims.

C. The Examiner notes that claim 1, lines 25-27 recites, “aryl is phenyl, naphthyl, or heteroaryl,” and asks whether aryl includes heteroaryl rings. While claim 1

has been canceled herein, similar language appears in new claim 11 (reciting that “aryl is chosen from phenyl, naphthyl and heteroaryl.” Applicants assert that, as is clear from the claim language, aryl may include heteroaryl rings. As the Examiner has failed to specifically articulate why the claim language is believed to be indefinite, Applicants respectfully traverse the rejection or request the Examiner clarify the basis for the rejection on the record.

D. Claims 1-4, reciting as a variable “optionally substituted by one or more identical or different substituents,” have been rejected as indefinite. According to the Examiner, the claims “remain silent about the exact and definite number of substituents and the exact position occupied by the same in a ring or chain (where applicable).” Office Action at 4. Again, Applicants respectfully traverse, as the Examiner has not articulated on the record precisely why the claim language is believed to be indefinite. Contrary to the Examiner’s assertions, the instant claims, as in the original claims, clearly and definitively identify the optional substituents as chosen from a list of substituents. Moreover, the instant claims recited that there is “at least one” substituent, and thus the number of substituents is clearly defined by the claims. See Part E, below. Finally, Applicants are not required to identify “the exact position occupied by” the substituent, as there are a limited number of possible positions, and “[b]readth of a claim is not to be equated with indefiniteness.” M.P.E.P. § 2173.04. Therefore, Applicants respectfully request reconsideration of this basis for rejection.

E. Claims 9 and 10 have been rejected for reciting “at least one.” According to the Examiner, “[t]he use of ‘at least one’ is not acceptable.” Office Action at 4. Applicants disagree. While claims 9 and 10 are canceled herein, new claims 11-15, 20,

and 28-34 also contain the phrase “at least one.” Applicants therefore traverse the rejection as it applies to claims 11-15, 20, and 28-34.

No where does either the M.P.E.P. or the courts forbid the use of the common claim term “at least one,” and the Examiner has failed to demonstrate otherwise. The 1957 case cited by the Examiner, *Petrolite Corp. v. Watson*, 113 U.S.P.Q. 248 (D.D.C. 1957), is not on point. In *Petrolite*, the court stated that “[n]egative limitations [including “at least one basic nitrogen” and “at least one carbon”, used in an effort to define the materials, result in uncertainty.” *Id.* at 249. The modern court, however, rejects this notion: “The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection are set forth definitively, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph.” M.P.E.P. § 2173.05(i).

Moreover, the phrase “at least one” is explicitly permitted by the M.P.E.P., as discussed in M.P.E.P. § 2173.05(h)II, which states that “at least one piece” has been held acceptable and not in violation of 35 U.S.C. § 112, second paragraph. Applicants therefore respectfully request reconsideration of the rejection.

V. Rejection under 35 U.S.C. § 112, First Paragraph

Claims 9 and 10 have been rejected under 35 U.S.C. § 112, first paragraph because, according to the Examiner, “the specification, while being enabling for treating a single and definite disorder (e.g. hypertension), does not reasonably provide enablement for treating or preventing disorders associated with a method for activating at least one soluble guanylate cyclase” Office Action at 4-5 (emphasis in original). Applicants disagree.

Applicants first point out that neither canceled claims 9 and 10, nor pending claims 11-34 are directed towards a method of "treating or preventing disorders associated with a method for activating at least one soluble guanylate cyclase." Indeed, Applicants fail to understand from where this language arises, but instead note that instant claim 29 is directed towards "[a] method for activating at least one soluble guanylate cyclase," whereas claims 30-34 are directed towards methods of treating specific disorders. As the Examiner has failed to show that the new claims 11-34 claims are not adequately enabled, Applicants respectfully request withdrawal of the rejection.

VI. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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